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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,417	01/18/2002	Mike Dooley	2388-796	1790
29540	7590	08/12/2003		
PITNEY, HARDIN, KIPP & SZUCH LLP 685 THIRD AVENUE NEW YORK, NY 10017-4024			EXAMINER	
			RADA, ALEX P	
		ART UNIT	PAPER NUMBER	
		3714	7	
DATE MAILED: 08/12/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Appli ation No.	Applicant(s)	
	09/890,417	DOOLEY ET AL.	
	Examiner Alex P. Rada	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____	6) <input type="checkbox"/> Other: ____

DETAILED ACTION

Response to Preliminary Amendment

In response to the preliminary response filed January 18, 2002, in which the applicant has amended claim 12 and claims 1-19 are pending in this office action.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features in claims 6, 12, 16-17, and 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact disc.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe how the remote control unit based on pulse patterns in the detected signals, where two

consecutive occurrences are separated by an interval that is longer than the response time of a human being does not produce a concrete and tangible result. The examiner requests the applicant to point in the specification the claimed subject matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the word, "preferably" is indefinite because the word "preferably" provides a narrow limitation with a broad limitation, which changes the scope of the claimed limitations.

7. The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 1 is indefinite because the phrase, the two consecutive occurrences are separated by an interval that is longer than the response time of a human being cannot be determined.

Claims 3, 4, and 11 all recite the limitation "the apparatus" in each of the claims. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

9. Claims 1-3, 6-7 and 10, as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Marshall '012.

10. Marshall discloses a remote controlled toy having a sensor which can detect signals, at least one unit which is controlled by a microprocessor in response to a program which is executed by the microprocessor, the toy element is adapted to determine the temporal occurrences of a user's activation of the remote control unit base on pulse patterns in the detected signals where two consecutive occurrences are separated by an interval that is longer than the response time of a human being, and to control the unit by selecting a program step in response to information in the temporal occurrences of a user's activations of the remote control unit as recited in claim 1; the toy element is adapted to respond to pulses of light and visible light as recited in claims 2 and 3; the intervals are longer than the smallest intervals which a human being can produce by an oscillating movement of the a part of the body as recited in claim 6; at least two different functions which are selected by means of signals from a remote control unit, a received signal for selection of function are adapted to emit a signal which depends on the received signal as recited in claim 7; the signal is emitted before the selected function is carried out as recited in claim 10.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4-5 and 8-9, as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall '012.

13. Marshal discloses the claimed invention as discussed above except for the apparatus is adapted to respond to sound pulses as recited in claim 4; the intervals are longer than 100, 200, or 300 milliseconds as recited in claim 5; the emitted signal is an acoustic signal and an optical signal as recited in claims 8-9. At the time of the invention was made, it would have been obvious matter of design choice to person of ordinary skill in the art to include a response to sound pulses, different intervals, and different types of emitted signals because Applicant has not disclosed that a response to sound pulses, different intervals, and different types of emitted signals provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any type of response to a signal and emitted signal because the ability provide a device to respond to any emitted signal and to emit any type of signal would not affect the functions of the apparatus. Therefore, it would have been an obvious design choice to modify Marshal to obtain the invention as specified in claims 4-5 and 8-9.

14. Claim 11, as best understood is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall '012 as in view of Lin '518.

15. Marshall disclose the claimed invention as discussed above except for the apparatus is adapted to compare a signal received from the remote control unit and to emit a first signal in the event that the received signal matches one of the expected signal and to emit a second signal in the event that the received signal does not match any of the expected signal.

Lin teaches comparing a signal received and emitting an event that the received signal matches one of the expected signal and to emit an event that the received signal does not match any of the expected signal. By comparing received signals with a plurality of expected signals, one of ordinary skill in the art would provide a toy that can be adjusted in accordance with various environmental conditions. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Marshall to include an apparatus adapted to compare a signal received from the remote control unit and to emit a first signal in the event that the received signal matches one of the expected signal and to emit a second signal in the event that the received signal does not match any of the expected signal as taught by Lin. To do so would provide a toy that can be adjusted in accordance with various environmental conditions.

16. Claims 12-19, as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall '012 in view of Nakada '901.

17. Marshall further discloses the reception of visible light as recited in claim 15 and the claimed invention as discussed above except for a receiver for reception of instructions for programming the toy as well as means for execution of received instructions having the toy has a transmitter for transmission of instruction s to a second toy as recited in claims 12, 17, and 19; the receiver is adapted for wireless reception instructions and receptions of infrared signals as recited in claims 13, 14, and 18.

Nakada teaches a receiver for reception of instructions for programming the toy as well as means for execution of received instructions having the toy has a transmitter for transmission of instruction s to a second toy (figures 2B and 3A) and the receiver is adapted for wireless

reception instructions and receptions of infrared signals. By having receiving instruction and transmitting instructions to a second toy using any form of wireless communication, one of ordinary skill in the art would provide a game in which toys compete against one another in strength and speed by being remote-controlled. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Marshall to include a receiver for reception of instructions for programming the toy as well as means for execution of received instructions having the toy has a transmitter for transmission of instructions to a second toy and the receiver is adapted for wireless reception instructions and receptions of infrared signals as taught by Nakada. To do so would provide a game in which toys compete against one another in strength and speed by being remote-controlled.

Both Marshall in view of Nakada do not expressly disclose a keyboard for manual input of instructions as recited in claim 16. At the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide a keyboard for manual input of instructions because applicant has not disclosed that a keyboard provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the different types of communications taught by Marshall and Nakada because a keyboard would provide the same end result as wireless or infrared signal. Therefore, it would have been an obvious matter of design choice to modify Marshall and Nakada to obtain the invention as specified in claim 16.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kawabe '708, Pelekis '844, Rosenthal '575, Okano '525, Benson '854, Chu '019, and Collier '920 all disclose different types of remote controlled light emitting means.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

APR
apr
August 6, 2003

Tom Hughes
S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
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